

Appl. No. 09/521,235
Response to Office Action mailed July 19, 2004
Response transmitted October 19, 2004

Attorney Docket No. 10022/112

REMARKS

1. Claims 1-24 are pending in the application. The Office Action has rejected Claims 1-6 and 13-24 under 35 U.S.C. § 101, as being drawn to non-statutory subject matter. Claims 1-24 are also rejected under 35 U.S.C. § 103(a) over several references. The Examiner is thanked for withdrawing previous rejections under 35 U.S.C. § 102(b).

2. The rejection under 35 U.S.C. § 101 states that independent Claims 1 and 13 read on a mental process or the manipulation of an abstract idea. The rejection further states that the claim limitations are not explicitly directed toward steps being implemented on a computer, computer readable medium, or other statutory device. As such, the steps could be carried out mentally, as by a person developing a dossier in his or her mind. Therefore, Claims 1 and 13, and dependent Claims 2-6 and 14-24, states the rejection, read on mental processes, which are non-statutory subject matter.

Applicants traverse the rejection. The specification makes it clear that the claims of the present invention apply, use, involve and advance computer technology and technological arts, thus constituting patentable subject matter. Nevertheless, to make it even clearer that the claims apply, involve, use or advance technological arts, Claims 1 and 13 have been amended in a non-narrowing fashion to make it clear that the dossier is developed using computers and information technology, as recited. The amendments to Claims 1 and 13 do not add new matter to the application. Support for the amendment is found at least in the specification on p. 11, lines 10-19, p. 36, line 28 to p. 38, line 2, and in Figs. 2 and 19-27.

3. Claims 1, 3-7, 9-13, and 15-19 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. No. 5,864,871 to Eduard Kitain. Applicants traverse the rejection for failure to present a prima facie case of obviousness.

The invention recited in Claim 1 is for a method of developing a dossier. The method concerns a client and a list consisting of industries associated with the client (emphasis added). Only industries with an association with the client are presented, not a general list of industries, or a list of all industries. Once the user presents or selects

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the name of a client, a list of industries consisting only of those industries associated with the client is presented. The user is then allowed to select an industry from the list, and the computer searches for information relating to the client and the selected industry. The last step of the method of Claim 1 is to prepare a dossier utilizing the information found during the searching.

Claim 1, the step of "presenting on a computer-user interface a list consisting of industries associated with the client"

The second step of Claim 1 is "presenting on a computer-user interface a list consisting of industries associated with the client" (emphasis added). This is not a list of random industries, or a list of all industries, as in Kitain, but rather a list of industries associated specifically with the client whose name was received in the previous step. M.P.E.P. 2111.03 (stating that the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim). As described in the specification, these industries are already associated with the client and stored in the information repositories. See specification, p. 36, lines 6-9, stating that "a list of industries associated with the client(s) is presented to the user in operation 1804."

The rejection admits that Kitain "does not explicitly teach 'industries associated with the client.'" Office Action, p. 4, lines 11-12. However, states the rejection, Kitain discloses in Fig. 3, "Advertising, Aerospace, Agriculture, Air Transportation, and Apparel & Textiles." The rejection then states that these five are "associated with industries," citing Fig. 3. The rejection then states that it would have been obvious to apply Kitain's teaching of "industries associated with the client" in order to allow remote users access and query information. But, as admitted on p. 4, lines 11-12 of the Office Action, Kitain has no teaching of "industries associated with the client."

The rejection fails to explain how a teaching of "5 Industries associated with industries" teaches "industries associated with the client." This is necessary, given that the rejection only states that Kitain receives a user's name and not that of a client. Lacking this piece of the puzzle, the rejection fails to make a *prima facie* case of obviousness. Claim 1 is therefore allowable, as are claims depending from Claim 1.

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Claims 2-6 and 19-24

Claims 2-6 and 19-24 depend from Claim 1 or claims depending from Claim 1, and are allowable at least because Claim 1 is allowable. The Examiner is respectfully requested to withdraw the rejection of Claims 2-6 and 19-24. In addition, a number of these dependent claims are also allowable because they include limitations not taught or suggested in the reference.

Claim 4

Claim 4, for a dossier arranged in sections according to people, documents and projects, is not taught or suggested by Kitain. The portion of Kitain cited as teaching Claim 4 is Fig. 7 and col. 47, lines 11-29. Fig. 7 is a bulletin board screen display, with what appears to be a series of reports organized by time of submission. The passage at col. 47, lines 11-29 concerns Fig. 7, but does not teach or suggest arranging the report into sections concerning people, documents and projects. The rejection simply states that "each report and item of corporate information is listed on a single line, with information about it," but does not teach or suggest arranging the report into sections. Office Action, p. 5, lines 1-4. Accordingly, Claim 4 is patentable over Kitain.

Claim 5

Claim 5 depends from Claim 4 and is allowable at least because Claim 4 is allowable. Claim 5 requires further organization and arrangement of the report after the sections required by Claim 4. As cited in the rejection, Fig. 7 shows reverse chronological order (latest reports first), but the passage cited, col. 7, lines 18-29, does not teach or suggest arranging according to the number of documents or projects an individual has produced related to the client or industry. Accordingly, Claim 5 is patentable over Kitain.

Claims 7 and 13

Claim 7 and amended Claim 13 are similar to Claim 1, but claim a computer program embodied on a computer readable medium for developing a dossier, and a

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computer system for developing a dossier. Applicants' arguments given above for method Claim 1 apply equally to Claims 7 and 13, because the rejections do not make out a prima facie case of obviousness against Claims 7 and 13. Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claims 7 and 13.

Claims 8-12 and 14-18

Claims 8-12 and 14-18 depend from Claim 7 or Claim 13, or from claims depending from them, and are allowable at least because Claims 7 and 13 are allowable.

In addition, some of these dependent claims have a separate reason for allowance. As discussed above for Claim 4, Claims 10 and 16 are allowable because the reference does not teach or suggest arranging the report into sections concerning people, documents and projects. As discussed above for Claim 5, Claims 11 and 17 are also allowable because the passage cited in the rejection, col. 7, lines 16-29, does not teach or describe arranging the people section of the report according to documents and projects a person has produced related to the client or industry. The Examiner is respectfully requested to withdraw rejections of Claims 8-12 and 14-18.

Claims 21-24

Claims 21-24 are also rejected over Kitain. The rejection for Claim 21 states that Kitain teaches "the list of associated companies is presented in response to receiving the name of the client," citing col. 21, lines 36-38. Office Action, p. 6, lines 1-2. The cited passage however, states that a company search generates a list of companies (named symbols) and places the list in a form from which the user can choose a company to perform a search upon. Claim 21, which depends from Claim 1, requires not a list of companies but a list of associated industries (emphases added). Accordingly, Kitain does not describe or suggest the limitations of Claim 21.

Claim 22 is rejected in view of Kitain, citing Fig. 3 and associated text. Claim 22, depending from Claim 21, further requires storing the association of one or more industries associated with the name of the client. Fig. 3, a document query screen form display, depicts a list of all contributors (stockbroker companies that have submitted reports) and

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all industries. The text describing Fig. 3 appears in Kitain from col. 40 to col. 41, line 53. There is no passage within these columns that describes or suggests storing an association of an industry with a client. Accordingly, Kitain does not describe all the limitations of Claim 22.

Claims 23-24 are rejected under the same rationale as Claims 21-22, and are allowable for the same reasons.

4. The Office Action rejects Claims 2, 8 and 14 as being unpatentable over U.S. Pat. No. 5,864,871 to Eduard Kitain in view of U.S. Pat. No. 6,327,588 to Mohamed Danish et al. ("Danish") under 35 U.S.C. § 103(a). The rejection admits that Kitain does not teach the step of "presenting an alternate list of industries not associated with the client," and states that Danish does teach this step, disclosing "a list box 15 comprising alphabetical listbox entries," and citing Danish, col. 5, line 62, to col. 6, line 10. See Office Action, p. 6, lines 7-14. Applicants traverse the rejections.

First, Claims 2, 8 and 14 are patentable because they depend from independent Claims 1 and 13, and are patentable because Claims 1 and 13 are patentable. Secondly, the claims are independently patentable because the rejection does not make out a *prima facie* case of obviousness.

The cited passage concerns a search using a list box containing both industry standard terms and proprietary terms for product families, and refers to Fig. 2. Danish, col. 5, lines 65-66. Fig. 2 clearly shows a list of parts, including connectors, terminals, and tabs (emphases added). These may be industry standard terms for product families, but they do not describe or suggest the claimed step of "presenting an alternate list consisting of industries not associated with the client." Lists of parts, industry standard terms, and product families are not lists of industries, and are not "an alternate list of industries not associated with the client" as claimed in Claims 2, 8, and 14. Moreover, Danish does not even teach or suggest a first list box containing parts associated with something, and then an alternate list containing parts NOT associated with that something. Applicants submit that Danish does not teach or suggest the limitations of Claims 2, 8, and 14.

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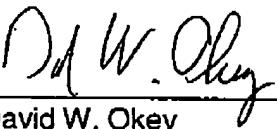
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As noted above, Kitain teaches a list of all industries, and does not teach lists consisting of industries associated with or not associated with the client. Kitain, col. 16, lines 16-17. Adding Danish as a reference does not cure this defect. Danish does not describe or suggest a list of industries "not associated with a client," and thus does not make obvious Claims 2, 8 and 14. The Examiner is respectfully requested to withdraw the rejection of Claims 2, 8, and 14.

5. Claim 20 is rejected as unpatentable under 35 U.S.C. § 103(a) over U.S. Pat. No. 5,864,871 to Eduard Kitain, in view of U.S. Pat. No. 6,240,410 to Kelly Wical et al. ("Wical"). First, Claim 20 is allowable at least because it depends from Claim 4, which is allowable. Second, Claim 4 recites that the dossier is arranged in sections according to people, documents, and projects; Claim 20, depending from Claim 4, further adds the limitation that the section includes displayed expandable nodes and subnodes. Wical concerns a hierarchical data structure, but does not teach or suggest a dossier, nor does Wical teach or suggest arranging a report by sections on people, documents, or projects. Thus, Wical and Kitain do not teach or describe the limitations of Claim 20, and the Examiner is respectfully requested to withdraw the rejection of Claim 20.

6. Applicants have shown that the references do not make obvious the claims of the invention because the references do not disclose all the limitations of the claims. Applicants respectfully request the Examiner to withdraw the rejections and to grant allowance of this application.

Respectfully submitted,



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